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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,134	02/27/2004	Roger P. Jackson	10,398	6767

7590 05/11/2006

John C. McMahon
PO Box 30069
Kansas City, MO 64112

EXAMINER

KIM, JOHN

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 05/11/2006

52

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/789,134	Applicant(s) JACKSON, ROGER P.	
	Examiner John Kim	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/19/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 8-9 are objected to because of the following informalities: Both claims are dependent claims that depend from themselves. For example, claim 8 states "The combination according to Claim 8..." These are improper dependent claims; thus, claims 8-9 are withdrawn from consideration.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haider (US. Pat. 6,740,098, cited in IDS) in view of Roussouly et al. (US Pat. 5,810,816, cited in previous office action).

Haider discloses a tool set or kit used for spinal surgery. He also teaches a "method of correcting this condition (scoliosis) is to surgically install a series of rods and supporting devices to reconfigure the spine..." (col 1 lines 25-26) Thus, a minimum of two Haider's invention is required for the surgery. Haider teaches a guide tool (26) that includes a channel that is adapted to receive a rod and guides the rod to the bone anchor (22). (see figures 1-6) He also includes the first helically wound guide tool and advancement structure (A) that will receive the mating structure (40) of a bone anchor closure top (42). Haider shows that the first guide (A) is also connected to the second

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guide and advancement structure (B) on the bone anchor, thus having a continuous helical pathway. (see below)

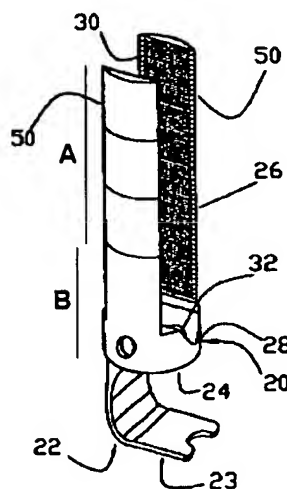


Fig. 1

Haider also discloses a lower attachment structure (38) that is attachable to the bone anchor (22). (see figure 4 and 6). Again, Haider shows there is a longitudinal pass and slot (figure 1) which can guide the rod to the bone anchor (22). The helically wound first (A) and second (B) guide and advancement structure, the continuous helical pathway, and the mating structure (40) of the bone anchor closure top (42), have been discussed above.

Haider also further discloses a tool set or kit that includes "a series of rods and supporting devices (anchors) to reconfigure the spine." (col 1 lines 26-7) In a series of anchors, the anchors closest to the patient's head and buttocks are considered as the end bone screws (anchors). Referring to Haider, these anchors work with the guide tools (26, figure 1), which are considered as end guide tools. The anchors in the middle are considered as the intermediate anchors, which also work with guide tools (26)

considered as intermediate guide tools. Both the end and intermediate guide tools (26) have their own attachment structure (38, see figure 4). Both guide tools have either a longitudinal guide channel or longitudinal pass through a slot (see figures 1-3) made by the arms (50). Haider teaches that a rod (33) will be received by the channel or pass. As discussed above, Haider teaches a first (A) and second (B) guide and advancement structure with a helically wound or helical pathway. The first (A) and second (B) guide and advancement structure are positioned and aligned to form a continuous helically wound path. Haider also teaches a closure top (42) that has a mating guide and advancement structure (40). Lastly, as shown by Haider in figures 5 and 6, the guides can be separated, thus considered as non-integral or be selectively joinably attached.

Haider discloses the claimed invention except for the bone anchor being a bone screw. Roussouly et al. (US Pat. 5,810,816) teaches that a bone screw and bone hook can be used interchangeably. "The present invention concerns anchors such as pedicle screws and hooks used for instrumentation of the spine, which are placed on the vertebrae to constitute anchor members linked together by one or more attachment rods." (col 1 lines 5-9) It would have been obvious to one skilled in the art at the time of the invention was made to construct the tool set or kit of Haider with the bone anchor being a bone screw rather than a bone hook in view of Roussouly et al, since these bone anchors are interchangeable.

Response to Arguments

Applicant's arguments filed 3/3/06 have been fully considered but they are not persuasive.

The objection for claims 8-9 still stand since applicant has failed to amend appropriately.

Applicant argues that their invention can be "selectively joined to the bone screw." Haider shows that the guides can be separated from anchor, and thus it is possible to "selectively join" the guides to the anchor, if a user so desires (possibly with glue or welding, etc). The amendments proposed by the applicant does not sufficiently overcome the prior art. With regard to intended use and other functional statements by the applicant, they do not impose any structural limitations on the claims distinguishable over Haider which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

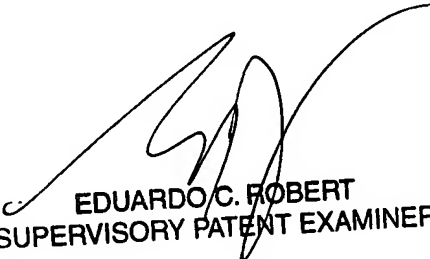
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (571) 272-2817. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JK



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER